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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,300	05/13/2002	Abraham Warshawsky	WARSHAWSKY=3	5740
1444	7590	12/17/2003	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			FORD, JOHN M	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	19/009300	Applicant(s)	Wojnowsky et al
Examiner	J.M. Foss	Group Art Unit	1634

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ~~THREE~~ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 14-13, 15-17, 22, 23 and 24 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 14-13, 15-17, 22, 23 and 24 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been  received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Action Summary

Applicants say in the second preliminary amendment: "rewrite claims 1, 4—13, 15—17, 22 and 23". Does that mean those are the only claims in the application?

Claims 2 and 3 were not repeated. Does that mean they are cancelled? No direction to cancel is found.

Please provide a clean copy of what is pending and cancel the rest.

See, new Rule 121.

I cannot tell if claim 14 is pending or not. Omission under the new Rule 121 constitutes cancellation.

Same question claims 18—21.

Same, claim 24.

Claims 2 and 3 violate 35 U.S.C. 101 and 35 U.S.C. 112, since they are drafted in terms of use. See Clinical Products vs. Brenner, 255 F. Supp. 151; 149 USPQ 475 (D.C. District Columbia 1966).

Claim 4 is rejected as a result of the use of the words "preferably 2", line 3  
of the claim. This creates a genus and a sub-genus in the same claim; 35 U.S.C.  
112, 4<sup>th</sup> paragraph.

Lipid peroxidation cannot be seen to rise to the level of a specific disease in claim 1; 35 U.S.C. 112, 1<sup>st</sup> paragraph.

See claims 15—17. A neurodegenerative disorder is not one specific disease. (Claim 15) See 37 CFR 1.475.

In regard to claim 16, Parkinson's disease has no established regimen of treatment (35 U.S.C. 101).

Claim 1 is rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. Is compound formula I and compound formula II in a mixture used together, at all times?

R1 is said to be a hydrocarbyl. What size? How many carbons? Linear or cyclic? Is it aromatic? The utility, though vague, is pharmaceutical. Large hydrocarbons would be waxes and tars, unacceptable as a pharmaceutical. R2 is a hydrophilic radical could not be allowed, that is not enough to say clearly and exactly what is being claimed.

Claim 4 is rejected. Preferably is also found in line 4. An open hydrocarbon in R1 is not acceptable.

In claim 5, a bulky group line 8, "such as" line 9 is not proper claim language, "such as" appears again in line 12. This is not proper claim language. See Ex parte Cordova, 10 USPQ 2<sup>nd</sup> 1949.

Claim 8 is rejected under 35 U.S.C. 112. See "preferably" in lines 4 and 5. Preferably is in the penultimate line of claim 10. That renders the claim indefinite (35 U.S.C. 112).

In claim 22, what is the purpose of the "excluding"? Is that prior art? See In re Nomiya et al., 184 USPQ 607.

Close related art renders adjacent art obvious under 35 U.S.C. 103.

A new 1.105 is added to read as follows:

**1.105 Requirements for information.**

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination preceding, the examiner or other Office employee may require the submission, from individuals identified under 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter.

The next adjacent compound would be structurally obvious. See, *In re Dillon*, 919 F.2d at 696, 16 U.S.P.Q. 2d at 1904. See also *Deuel*, 51 F.3d at 1558, 34 U.S.P.Q. 2d at 1214 (“Structural relationships may provide the requisite motivation or suggestion to modify one compound to obtain another compounds. For example, one compound may suggest its homologs, because homologs often have similar properties, and, therefore, chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties, or merely to satisfy their production goals.

Other structural similarities have been found to support a *prima facie* case of obviousness. E.g., *In re May*, 574 F.2d 1082, 1093-95, 197 U.S.P.Q. 601, 610-11 (CCPA 1978) (stereo isomers); *In re Wilder*, 563 F.2d 457, 460, 195 U.S.P.Q. 426, 429 (CCPA 1977) (adjacent homologs and structural isomers); *In re Hoch*, 428 F.2d 1341, 1344, 166 U.S.P.Q. 406, 409 (CCPA 1970) (acid and ethyl ester); *In re Druey*, 319 F.2d 237, 240, 138 U.S.P.Q. 38, 41 (CCPA 1963) (omission of methyl group from pyrazole ring).

A compound need not be a homolog or isomer of a prior art compound in order to be susceptible to a rejection based on structural obviousness.

Thus, a difluorinated compound was held unpatentable over the prior art dichloro compound on the basis of analogical reasoning. Ex parte Wiseman (POBA 1953) 98 U.S.P.Q. 277.

R1 and R2 of claim 22 are rejected for the reasons noted in the rejection of claim 1.

What is the purpose of the compounds excluded in claims 23 and 24?  
~~A~~ddjacent compounds would be structurally obvious (35 U.S.C. 103) from the prior art.

Any claim not specifically rejected, is rejected as being dependent on a rejected claim.

Content in a 371 application is governed by 37 CFR 1.475. In the instance of multiple compounds one need be elected. Formula II or formula I, not both. Applicants should elect which they want examined on the merits, here, against the art. Applicants, likewise, should elect one use. Claim 17 is suggested. Read Rule 475 and PCT Rule 13.2.

A one-page "Abstract is requested to the elected invention.

Formula II keeps the application with me.

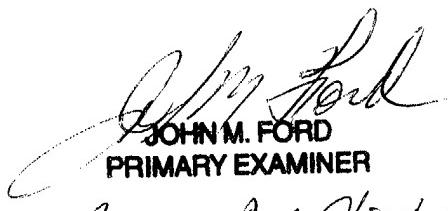
Formula I go elsewhere in class 564.

**Completeness of examiner's action.**

The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable. (emphasis added).

J. M. Ford:jmr

December 4, 2003

  
JOHN M. FORD  
PRIMARY EXAMINER  
